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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85792870
Applicant	Golden Software, Inc.
Applied for Mark	QUARRIER
Correspondence Address	JAMES A SHERIDAN SHERIDAN LAW LLC 1600 JACKSON ST STE 350 GOLDEN, CO 80401-1994 UNITED STATES jsheridan@sheridanlaw.com
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Filer's Name	James A. Sheridan
Filer's e-mail	jsheridan@sheridanlaw.com
Signature	/James A. Sheridan, 43114/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK AND APPEAL BOARD**

In re Application of:  
Golden Software Inc.

Serial No.: 85/792,870

Filed: December 6, 2012

Mark: QUARRIER

Examining Attorney: Mary E. Crawford

Law Office: 102

**BRIEF OF THE APPLICANT**

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## **I. INTRODUCTION**

Applicant Golden Software, Inc. hereby appeals the refusal by the examining attorney at the United States Patent and Trademark Office (“USPTO”) to register the mark QUARRIER (the “Mark”) for “computer aided manufacturing (CAM) software for production planning and inventory management for the aggregate industry, namely, CAM software for production scheduling and equipment optimization” and respectfully request that the Board reverse the refusal.

## **II. GROUNDS FOR APPEAL**

Appellant filed an application to register the Mark on December 6, 2012. The examining attorney issued a final refusal to register the Mark on April 29, 2015. The examining attorney refused registration of the Mark relying on Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e), stating that the Mark is merely descriptive of Applicant’s goods. Thereafter, on August 13, 2015, Appellant filed its Request for Reconsideration with the USPTO concurrently with its Notice of Appeal before the Board pursuant to 15 U.S.C. §§ 1062(b), 1070 and 37 CFR § 2.141. The examining attorney denied Applicant’s request for reconsideration on September 1, 2015, and this brief is timely filed pursuant to 37 CFR § 2.142 and the Board’s Order of September 17, 2015.

## **III. ARGUMENT**

Applicant respectfully submits that the mark QUARRIER for Applicant’s services is a mark created by Applicant that is at most suggestive and that is not merely

descriptive of Applicant's goods. It is therefore deserving of registration on the Principal Register.

The Examining Attorney may refuse to register a mark if the mark "when used on or in connection with the goods of the Applicant is merely descriptive... of them."

(Emphasis added). 15 U.S.C § 1052(e)(1). A mark is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the products and services it identifies. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the goods and services for which registration is sought, not in the abstract. TMEP § 1209.01(b) (Emphasis added). This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

Moreover, the mark must give some reasonably accurate or tolerably distinct knowledge of the essence of the good or service. If the information conveyed by the mark is indirect or vague, the mark is being used in a suggestive rather than a descriptive manner. J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §11:19 (4<sup>th</sup> Ed.); *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 699, 131 USPQ 55 (2d Cir. 1961) ("Unless a word gives some reasonably accurate- some tolerably distinct knowledge- as to what the product is made of, it is not descriptive within the meaning of trademark terminology." "Poly Pitcher" was not descriptive of a polyethylene

pitcher.) If a consumer has to exercise “mature thought or follow a multi-stage reasoning process” to determine the characteristics of a product or service, then the mark is suggestive, not descriptive. *In re Tennis in the Round, Inc.*, 199 U.S.P.Q. 496, 498 (TTAB 1978) (“This association of applicant’s mark with the phrase ‘theater-in-the-round’ creates an incongruity...,” thus TENNIS IN THE ROUND is not merely descriptive of tennis facilities.) Furthermore, “[t]he primary criterion is the imaginativeness involved in the suggestion, that is, how immediate and direct is the thought process from the mark to the particular product.” *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979); *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Conveniently, the Trademark Trial and Appeal Board has codified these rules and adopted a three-part test to help determine whether a mark is descriptive or suggestive: (1) the degree of imagination necessary to understand the product; (2) a competitor’s need to use the same terms; and (3) competitors’ current use of the same or similar terms. *No Nonsense Fashions, Inc. v. Consolidated Food Corp.*, 226 USPQ 502 (TTAB 1985). Applying the test to Applicant’s case it becomes obvious that the mark QUARRIER is not merely descriptive.

**A. A Mental Step is Required to Arrive at the Character of Applicant’s Goods and Therefore the Mark QUARRIER is Not Merely Descriptive**

Courts have typically found that “[i]f the mental leap between the word and the product’s attributes is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness.” *Self-Realization Fellowship Church v. Ananda Church of*

*Self- Realization*, 59 F.3d 902, 911 (9th Cir. 1995) (citing *Investacorp, Inc. v. Arabian Inv. Banking Corp*, 931 F.2d 1519 (11th Cir. 1991)).

Applying the first factor to Applicant's case, it is evident that the mark QUARRIER does not instantaneously invoke the Applicant's goods. Merriam-Webster's Dictionary defines "quarrier" as "a worker in a stone quarry". "quarrier." *Merriam-Webster.com*. 2015. <http://www.merriam-webster.com> (16 September 2015). Furthermore, Merriam-Webster's Dictionary defines "quarry" as "an open excavation usually for obtaining building stone, slate, or limestone." "quarry." *Merriam-Webster.com*. 2015. <http://www.merriam-webster.com> (16 September 2015). Applicant's mark is for "computer aided manufacturing (CAM) software for production planning and inventory management for the aggregate industry, namely, CAM software for production scheduling and equipment optimization." It is not instantaneously evident from the definition of "quarrier" that the applicant's goods refer to computer aided manufacturing software. Even withstanding the fact that the software is used for the purpose of production planning and inventory management for the aggregate industry, there still exists a degree of imagination that is required for a consumer to associate the mark QUARRIER with software. Thus, at best, the term is suggestive, not merely descriptive.

Moreover, it is important to note that the Applicant's goods, the computer aided manufacturing software, does not itself perform the same function as a quarrier. That is to say that software itself cannot physically excavate stone as a quarrier (i.e., stone excavation worker) could in a stone quarry. Thus, the mark cannot be descriptive.



**B. A Competitor Need Not Use The Same Term**

The second factor in determining whether a mark is descriptive or suggestive also weighs in the Applicant's favor. A competitor has no need to use the term "quarrier" in selling CAM software. A number of competitors currently sell similar software without using the term. Moreover, the term "quarrier" is so uncommonly used that it appears in *A Dictionary Of Archaic And Provincial Words: Obsolete Phrases, Proverbs And Ancient Customs From The Fourteenth Century*.

**C. The USPTO Has Approved A Similar Mark**

The USPTO has registered the mark QUARRY, (Reg. # 4548299) for "Software for automated processing of data and workflow management". Despite the similarities in both the marks QUARRY and QUARRIER, as well as the similarities in the types of goods, the USPTO did not find the mark QUARRY to be merely descriptive. Similarly, the TTAB ought not find the mark QUARRIER merely descriptive for the same reasons.

**D. The Examining Attorney Has Not Established That Applicant's Mark Is Merely Descriptive Rather Than Suggestive**

Applicant respectfully submits in that regard that the examining attorney has not submitted any evidence that the term "quarrier" is used to describe software in the context of a production planning and inventory management for the aggregate industry, namely, computer aided manufacturing software for production scheduling and equipment optimization. In other words, given the meaning of "quarrier," which includes significance in the field of manual stone excavation by a laborer, a prospective consumer viewing the mark QUARRIER will perceive the term as incongruous in relation to

applicant's sophisticated and expensive computer aided manufacturing software. For this reason, Applicant's use of the term in connection with its software in the field of computer aided manufacturing is incongruous and requires the kind of mental pause that separates suggestive marks from merely descriptive ones. See, e.g., *In re Shutts*, 217 U.S.P.Q. 363, 356-65 (TTAB 1983). Compare, for example, *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ382 (CCPA 1968); and *In re Tennis in the Round, Inc.*, 199 USPQ 496 (TTAB 1978).

**E. An Application Should Proceed to Publication When People Can Reasonably Differ as to the Mark's Descriptiveness**

Finally, if doubt exists as to whether a term is merely descriptive, it is the practice of the TTAB to resolve doubts in favor of the applicant and pass the application to publication. See *In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972). In this way, anyone who believes that the term is, in fact, descriptive, may oppose and present evidence on this issue to the Board.

**IV. CONCLUSION**

For the foregoing reasons, Appellant requests that the Board grant Applicant's *Ex Parte* Appeal and to allow for registration of the Mark.

Respectfully submitted,  
Sheridan Law LLC

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By: /James A. Sheridan 43114/  
James A. Sheridan  
Attorney for Applicant  
Tel: (303) 953-9083